REMARKS

Claims 1, 3, 4 and 7-11 are now pending in the present application. Claim 1 has been amended to recite "the organic fine particles exhibit high hardness, have a glass transition temperature of higher than 50°C, are crosslinked substances, and do not melt or decompose during thermal drying of the paint composition". Support for this amendment to claim 1 can be found at page 15, lines 22-24 and 29-32 of the specification. Claims 2, 5 and 6 have been cancelled. Claims 7-11 have been newly added. Support for newly added claim 7 can be found on page 13, lines 21-22 of the specification. Support for claim 8 can be found on page 14, lines 8-11. Support for claim 9 can be found on page 15, lines 26-29. Support for claim 10 can be found on page 16, lines 16-18 of the specification. Support for claim 11 can be found on page 16, line 28 to page 17, line 2 of the specification. None of these amendments introduce new matter.

The rejection of claims 2, 5 and 6 under 35 USC 112, second paragraph, has been rendered moot by the cancellation of these claims.

Claims 1-2, 4 and 6 were rejected under 35 USC 102(b) as being anticipated by US Patent 6,228,934 to Horowitz et al. (hereinafter also referred to as "Horowitz"). Horowitz does not anticipate claims 1-2, 4 and 6.

Horowitz suggests a method for producing a suspension comprising amorphous polymer particles. In the production method of Horowitz, the suspension comprising crystalline or semi-crystalline polymer particle is heated to a temperature effective to cause the polymer to become amorphous followed by cooling the suspension below the melting point of the polymer. The suspension of Horowitz comprises a suspension of a suspension solvent and polymer particles.

On the other hand, the paint composition for thermal drying of the present invention comprises an emulsion and organic fine particles. Thus, the suspension of Horowitz is different from the paint composition for thermal drying of the present invention.

In addition, in the suspension of Horowitz, the suspension is heated so that the polymer particles in the suspension become amorphous. However, the suspension after heating is still a

suspension, namely, the suspension solvent is not removed by vaporization with the heat which changes the polymer particles to being amorphous. In the thermal drying of the paint composition, the composition is heated so that the solvent in the composition is removed by vaporization in the thermal drying. And the organic fine particles of the present invention are specified to those that do not melt or decompose during thermal drying of the paint composition. Thus, the organic fine particles of the present invention differ from the polymer particles suggested by Horowitz. Therefore, the paint composition for thermal drying of the present invention is different than the suspension of Horowitz.

Claims 1, 2, 4 and 6 were rejected under 35 USC 102(b) as being anticipated by US Patent 3,196,122 to Evans et al. (hereinafter referred to as "Evans"). Evans does not anticipate claims 1-2, 4 and 6.

Evans suggests a cement composition. Column 3, lines 7 and column 4, line 4 describes polyacrylic latices. Column 4, lines 13-15 described the use of an emulsifier in the production of the polyacrylic latices.

However, Evans fails to disclose a composition which comprises an emulsion and organic fine particles. Thus, the cement composition of Evans differs from the paint composition for thermal drying of the present invention.

Claims 1-6 were rejected under 35 USC 102(b) as being anticipated by or in the alternative, under 35 USC 103(a) as being obvious over US Patent 3,830,761to Lenney. Lenney does not anticipate claims 1- 6 nor does Lenney render them obvious.

Lenney suggests an interpolymer composition which comprises the interpolymer made from vinyl chloride, ethylene and vinyl acetate and a protective colloid. Lenney suggests the emulsion polymerization of latex paints having 20 to 10°C of Tg and 0.25 micron of particle size, and production temperature of up to not much in excess of 80°C. However, Lenney fails to disclose or suggests a composition which comprises an emulsion and organic fine particles. Thus, the cement composition of Lenney differs from the paint composition for thermal drying of the present invention.

The paint composition for thermal drying of the present invention comprises the emulsion of which a glass transition temperature and organic fine particles of which a mean particle diameter is specified. And due to this, the occurrence of blister is suppressed and the thermal drying characteristics become excellent, thereby making the paint composition a favorable material for forming a thick film.

The present invention is achieved by optimization of the components of the composition, and shows superior results and unexpected advantages as compared to the prior art.

The cited references disclose nothing specifically with respect to the combination of the specific emulsion and specific organic fine particle, nor do they focus on the importance of such aspect.

The cited references fail to anticipate the present invention. In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. *See Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. *See Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

Also, the cited art lacks the necessary direction or incentive to those or ordinary skill in the art to render a rejection under 35 USC 103 sustainable. The cited art fails to provide the degree of predictability of success of achieving the properties attainable by the present invention needed to sustain a rejection under 35 USC 103. See *Diversitech Corp. v. Century Steps, Inc.* 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 187 USPQ 774 (CCPA 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 USC 103. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d. 1923 (Fed. Cir. 1990), *In re Antonie*, 195, USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ 519 (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property can be ignored in determining patentability and comparing the claimed invention to the cited art. Along these lines, see *In re Papesch*, supra, *In re Burt et al*, 148 USPQ 548 (CCPA 1966), *In re Ward*, 141 USPQ 227 (CCPA 1964), and *In re Cescon*, 177 USPQ 264 (CCPA 1973).

Accordingly, the present claims are patentable over the cited reference.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

In the event that the Examiner believes that another interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

Please charge $1020.00 or any other fee due with this response to our Deposit Account No. 22-0185, under Order No. 21581-00318-US from which the undersigned is authorized to draw.

Dated: 9-13-06

Respectfully submitted,

By _____
Burton A. Amernick
Registration No.: 24,852
CONNOLLY BOVE LODGE & HUTZ LLP
1990 M Street, N.W., Suite 800
Washington, DC 20036
(202) 331-7111 (Phone)
(202) 293-6229 (Fax)
Attorney for Applicant